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In re Application of : DECISION ON
John W. WONG et al. :
Application No.: 09/424,431 :
PCT No.: PCT/US98/10389 : PETITION
Int. Filing Date: 22 May 1998 :
Priority Date: 23 May 1997 : UNDER 37 CFR 1.48(a)
Attorney's Docket No.: 2873-000022/USA :
For: METHOD AND APPARATUS FOR :
DELIVERING RADIATION THERAPY DURING :
SUSPENDED VENTILATION :

This decision is in response to the "Response to Notification of Missing Requirements Under 35 U.S.C. 371" filed 16 March 2000. The "Response to Notification of Missing Requirements" is being treated as a petition under 37 CFR 1.48(a) to add inventor John R. MUSSELWHITE. The requisite petition fee under 37 CFR 1.17(i) of \$130.00 has been charged to Deposit Account No. 08-0750 per the authorization found in the 16 March 2000 "Response to Notification of Missing Requirements."

BACKGROUND

On 22 May 1998, applicants filed international application PCT/US98/10389, which claimed priority to U.S. provisional application 60/063,454, filed 23 May 1997. A Demand for international preliminary examination, in which the United States was elected, was filed 18 December 1998. Accordingly, the thirty month period for paying the basic national fee in the United States in accordance with 37 CFR 1.495(b), expired at midnight on 23 November 1999.

On 23 November 1999, applicants filed a Transmittal Letter (Form PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic national fee, as well as the requisite surcharge for furnishing the oath or declaration later than thirty months from the earliest claimed priority date.

On 24 January 2000, the United States Designated/Elected Office mailed a "Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) indicating that an oath or declaration executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68 was required. The Notification set a one (1) month period for response.

On 16 March 2000, applicants submitted a "Response to Notification of Missing Requirements Under 35 U.S.C. 371." The Response included, *inter alia*, a petition and requisite fee for a one month extension of time and a Declaration and Power of Attorney executed by inventors John W. WONG, David A. JAFFRAY, and Michael B. SHARPE originally listed in the international application, and also executed by additionally listed inventor John R. MUSSSELWHITE, and authorization to charge any other necessary fees.

DISCUSSION

A petition under 37 CFR 1.48(a) must be accompanied by (1) a petition including a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part; (2) an oath or declaration by the actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43, or 1.47; (3) the fee set forth in 37 CFR 1.17(i); and (4) if an assignment has been executed by any of the original inventors, the written consent of the assignee (see 37 CFR 3.73(b)). The petition lacks items (1) and (4) above.

With regard to item (1), the petition lacks a statement from John R. MUSSSELWHITE that the error in inventorship occurred without deceptive intention on his part.

With regard to item (4), MPEP 201.03 states in part:

The written consent of every existing assignee of the original inventors must be submitted. 37 CFR 1.48(a)(4). 37 CFR 1.48(a) does not limit assignees to those who are recorded in the Patent and Trademark Office records. The Office employee deciding the petition should check the file record for any indication of the existence of an assignee (e.g., a small entity statement from an assignee).

Where no assignee exists petitioner should affirmatively state that fact. If the file record including the petition is silent as to the existence of an assignee it will be presumed that no assignee exists. Such presumption should be set forth in the decision to alert petitioners to the requirement.

In the present case, the "Response to Notification of Missing Requirements" submitted 16 March 2000 included an assignment to William Beaumont Hospital and the international application lists William Beaumont Hospital as an applicant. Such designations appear to

application lists William Beaumont Hospital as an applicant. Such designations appear to indicate a proprietary interest in William Beaumont Hospital and create a presumption of the existence of an assignee. If such presumption is correct, the written consent of the assignee is required to satisfy the requirements of 37 CFR 1.48(a). If such presumption is not correct, petitioner should affirmatively state that no assignee exists. Petitioner has not provided either the written consent of the assignee or a statement that no assignee exists.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.48(a) is DISMISSED.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to provide the proper reply will result in abandonment of the present application. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.48(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

A proper reply must include: 1) a statement from Mr. Musselwhite that the error in inventorship occurred without deceptive intent on his part and 2) written consent of the assignee as discussed above.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner of Patents, Box PCT, Washington, D.C., 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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